

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed June 17, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 112, Second Paragraph**

Claim 1 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. In particular, the Examiner states that the phrase "from the user of a person that the user authorizes" in claim 1 is indefinite. Applicant disagrees.

In claim 1, two different parties are clearly defined, a "user" and a "person". Applicant believes that the identities of these parties is clear from the context of claim 1 and therefore has elected not to amend claim 1. Applicant requests that the rejection be withdrawn.

### **II. Claim Rejections - 35 U.S.C. § 103(a)**

Claims 1-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown (U.S. Pub. No. 2002/0156895) in view of Adamson (U.S. Pat. No. 5,818,442). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d

1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

**A. Claims 1-7 and 21-23**

Independent claim 1 provides as follows (emphasis added):

1. A method for sharing contact information, comprising:  
storing a user's contact information *in a publicly-accessible database that is accessed over a network;*  
*receiving identification from the user of a person that the user authorizes to access the user's contact information;*  
receiving a request from the authorized person to access the user's contact information; and

transmitting the user's contact information to a computing device of the authorized person from the database via the network in response to the request.

In the Office Action, it is argued that Applicant admits that it is known to store a user's contact information in a publicly-accessible database that is accessed over a network. The Office Action admits, however, that Applicant does not disclose "receiving an identification and request from an authorized user to access contact data and exchanging contact information between authorized users." Finally, the Office Action argues that Adamson teaches such receiving, requesting, and exchanging and, in view of that teaching, Applicant's claims 1 and 15 would have been obvious.

Irrespective of whether Applicant admits or does not admit that it is known to store contact information in a publicly-accessible database, Applicant asserts that there is no motivation provided by the prior art to combine the teachings of Adamson with the so-called admissions of Applicant. As was noted in the previous Response, Adamson only discloses storing contact information in relation to a general purpose electronic conference (GPEC) application that is accessible *only* to participants of an electronic conference. Adamson, column 7, lines 10-28. There is simply no suggestion in the prior art that aspects of Adamson's electronic conferencing system can or should be added to a publicly-accessible database that stores contact information. Clearly, the only such suggestion is provided by Applicant's own disclosure of the claimed invention (which explicitly teaches controlling access to such contact information). As is well established in the law, such hindsight to the Applicant's own disclosure is improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively

culled from the prior art to fit the parameters of the invention). Given that no such motivation or suggestion is provided by the prior art, it appears that the proposed combination was made to simply satisfy each of Applicant's individual claim limitations without regard for the propriety of that combination. For at least the foregoing reasons, the rejection should be withdrawn.

Even if the Adamson teachings were properly combinable with Applicant's so-called admitted prior art, such combination would still not result in Applicant's claimed invention. Specifically, there is no teaching in Applicant's "admitted" prior art or the Adamson reference as to how aspects of Adamson's system could be integrated with the system of the "admitted" prior art. Again, the "admitted" prior art teaches a publicly-accessible database of contact information, while Adamson teaches an electronic conferencing system. Adamson's "control" over access merely relates to gaining access to the conference. Once such access is obtained, no further measures are required to access the contact information. Such a control scheme simply does not fit within the system of the "admitted" prior art, and neither reference contains any indication as to how to transform that control scheme to suit the "admitted" prior art system.

With particular regard to dependent claim 4, neither of the cited references teach or suggest receiving an "email address" as an "identification" of a person that the user "authorizes to access the user's contact information".

Regarding dependent claim 5, neither reference teaches or suggests adding a person's identity to an "approved list".

Regarding dependent claim 6, neither reference teaches or suggests "receiving an indication from the user as to *what pieces* of contact information to make accessible".

Regarding dependent claim 21, neither reference teaches or suggests “receiving an indication as to which of *multiple groups of information* to make accessible to the authorized person”. Applicant notes that the Examiner did not address this limitation and instead merely indicated that it is obvious for the same reasons as claim 6 (which does not comprise the limitation). Adamson only describes sharing of a business card. Nowhere is it stated that different groups of information (e.g., different business cards) of the same person can be shared.

Regarding dependent claims 21 and 23, neither reference teaches or suggests a “personal information group”, a “business information group”, or “manual selection of each piece of information to make accessible to the authorized person”.

#### **B. Claim 14**

Independent claim 14 provides as follows (emphasis added):

14. A method for sharing contact information, comprising:  
storing a user's contact information in a web server accessible  
via the Internet;

*receiving from the user an identification of one or more  
persons that the user authorizes to access the user's contact  
information;*

*receiving identification of what pieces of contact information  
to share with each authorized person;*

receiving a request from a person to view the user's contact  
information;

*verifying authorization of the person to view the user's  
contact information and the level of access for which the person is  
approved; and*

***transmitting to the person only the pieces of contact information that the person is authorized to view.***

Regarding claim 14, neither cited reference teaches or suggests “receiving identification of what pieces of contact information to share with each authorized person” or “transmitting to the person only the pieces of contact information that the person is authorized to view” for reasons described in the foregoing. Moreover, neither reference teaches or suggests “verifying authorization of the person to view the user’s contact information and the level of access for which the person is approved”. In fact, neither reference mentions any “level of access”.

#### **C. Claims 15-17**

Independent claim 15 provides as follows (emphasis added):

15. A system for sharing contact information, comprising:  
***means for storing a user’s contact information in a location that is publicly-accessible over a network;***  
***means for receiving an identification of one or more persons that a user authorizes to access the user’s contact information;***  
means for receiving requests from persons to access the user’s contact information; and  
means for transmitting the user’s contact information to computing devices of authorized persons from the database in response to the requests.

Regarding claim 15, Adamson does not teach “means for storing a user’s contact information in a location that is publicly-accessible over a network” or “means

for receiving an identification of one or more persons that a user authorizes to access the user's contact information" for reasons described in the foregoing.

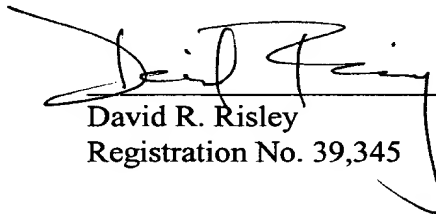
**D. Conclusion**

In summary, it is Applicant's position that Applicant's claims are patentable and that the rejection of these claims should be withdrawn.

### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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